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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,195	10/07/2003	Martin Kustermann	VOI0181.CIP	3263

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EXAMINER	
LAMB, BRENDA A	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/667,195	Kustermann et al
Examiner	**Group Art Unit**
LAMB	1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☑ Responsive to communication(s) filed on 2/28/2005.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-39 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☑ Claim(s) 10-39 is/are allowed.

☑ Claim(s) 1, 2, 5 and 7-17 is/are rejected.

☑ Claim(s) 3-4 and 6 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☑ Interview Summary, PTO–413

☑ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

The finality of the last office action mailed 12/28/2004 is withdrawn and as directed a rejection of the claims under newly cited art is set forth below.

Claims 9-15 and 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "said intermediate layer" in claim 5 lack proper antecedent basis. Claim 9 depends on claim 13 and claim 13 depends on claim 9 and therefore unclear how claims 9 and 13 relates to independent claim 1 or to each other.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5, 7-9 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa et al in view of Carlson et al.

Sawa et al teaches an apparatus for application of a medium, toner, to a moving paper fiber substrate (see column 1 lines 8-23). The Sawa et al apparatus is comprised of the following elements: an applicator unit configured for applying a medium, toner, to a substrate; and a roll capable of guiding the web within the apparatus, the roll including: a core having an outer surface; and a compressible covering formed of an elastomeric material, the elastomeric material having cavies being of a substantially uniform size. Sawa et al infers at column 6 lines 24-25 the cavities are substantially uniformly distributed cavities on the foamed product in order to provide to provide uniform cells at the cited density and in any event one would obviously want the cavities uniformly distributed in the roller cover to provide uniform compressibility of the covering of the roller. Sawa et al fails to teaches a bonding layer joining the covering to the outer surface of the core. However, it would have been obvious have been obvious to modify the Sawa et al in the coating apparatus to provide a bonding or adhesive layer between its core and covering to securely adhere the compressible covering to core since Carlson et al teaches using an adhesive material between the core and covering in order to secure different materials to one another to obviously prevent displacement of the layers over time in use of the coating roll. Thus claim 1 is obvious over the combination of Sawa et al and Carlson. With respect to claim 17, Sawa et al shows as shown in Figure 6 a compressible covering which is an outer covering of the roll and reads as shown reads on a monolithic covering (see pages 5-7 of the translation of

Becker). With respect to claim 2, the examiner has interpreted the recitation that the at least one intermediate layer disposed within said outer functional layer as meaning the at least one intermediate layer disposed closer to the axis of the core than the outer functional layer as depicted in applicant's drawings. Although Sawa et al fail to teach the covering has layers, it would have been obvious to modify the Sawa et al roller by providing the covering on the roller as a series of identical layers rather than a single layer especially since Carlson discloses at column 5 lines 38-41 that the roll covering may be formed as more than one layer dependent on ambient temperature and size of the roll core. With respect to claim 16, although Sawa et al fails to teach the foam is cross-linked on the core, Carlson et al teaches the foam material is poured and cured on the metal core and cross-linked using the disclosed foam composition (see Example 3 for disclosure of a foam using a cross-linking agent). With respect to claim 5, the examiner has interpreted for examination purposes the recited thickness of the intermediate layer as being the thickness of the covering. Therefore, although Sawa et al fails to teach the thickness of the covering, it would have been an obvious matter of design choice to provide the Sawa et al roller with a covering thickness within the scope of claim 5 since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). With respect to claim 9, the examiner has interpreted for examination purposes that the instant claim is dependent on claim 1. Sawa et al teaches the compressible covering is an outer covering of the roll and as shown in Figure 6 reads on a monolithic or one-piece covering. With respect

to claim 13, the broad recitation that the cavities/cells being one of filled (or closed) and open-celled does not structurally further limit applicant's invention over Sawa et al in that cells in foamed materials include two different forms- open or filled/closed and the Sawa et al cavities/cells in the covering has to exhibit one of the two different forms. With respect to claims 14-15, Sawa et al teaches in his examples disclosed at column 3 line 60 to column 7 line 14 the diameter ranges within the scope of the instant claims dependent on the desired stability of the roller against changes in the environment and in any event a change in size such the Sawa et al cavities/cells is generally recognized as being the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). With respect to claim 7, the same rejection applied to claim 13 is applied here. With respect to claim 8, the same rejection applied to claim 15 is applied here.

Applicant's arguments with respect to claims 1, 2, 5, 7-9 and 13-17 have been considered but are moot in view of the new ground(s) of rejection.

Claims 18-39 are allowed.

Claims 3-4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest an apparatus for direct application of a coating medium to a moving fiber material web, the apparatus comprising:

an applicator unit configured for applying the coating medium to the web; and

a roll configured for guiding the web, the roll including:

a core having an outer surface; a compressible covering formed of an elastomeric material, the elastomeric material having a plurality of substantially uniformly distributed cavities, the cavities being of a substantially uniform size; and

a bonding layer joining the covering to the outer surface of the core wherein the covering includes an outer functional layer and at least one intermediate layer disposed within the outer functional layer, wherein the outer functional layer is formed of a solid elastomer having a thickness of approximately between 1 and 15 mm or the intermediate layer having a hardness within the scope of the claims.

The prior art fails to teach or suggest an apparatus for indirect application of a coating medium to a moving fiber material web, the apparatus comprising: a backing device configured for supporting the web; an applicator unit configured for applying the coating medium; and a roll defining a press nip with the backing device, the press nip being configured for receiving the web, the roll being configured for receiving the coating medium from the applicator unit and transferring the coating medium to the web in the press nip, the roll including: a core having an outer surface; a compressible covering formed of an elastomeric material, the elastomeric material having a plurality of substantially uniformly distributed cavities, the cavities being of a substantially uniform size; and a bonding layer joining the covering to the outer surface of the core.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-

1231. The examiner can normally be reached on Monday and Wednesday through Friday with alternate Tuesdays off

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb
Examiner
Art Unit 1734